



S. Little
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#15/Reply
Brief

In the United States Patent and Trademark Office

Board of Patent Appeals and Interferences

Scott E. Johnston, Applicant Pro Se, Appellant

Appeal From Final Rejection of

James F. Hook, USPTO / GAU 3752, Primary Examiner

Appn. Number: 09/312,992

APPELLANTS' REPLY BRIEF

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This is in reply to examiner's answer dated December 17, 2001.

REAL PARTY IN INTEREST

Unchanged.

RELATED APPEALS AND INTERFERENCES

Unchanged.

STATUS OF CLAIMS

Unchanged.

STATUS OF AMENDMENTS

Unchanged.

SUMMARY OF INVENTION

Unchanged.

ISSUES

Unchanged.

CLAIMS APPEALED

Unchanged.

RESPONSE TO ARGUMENT

In as much as the examiner has elected to reference the numbering system used in the appeal brief, the appellant will follow the same format.

1.) Regarding argument 1, the appellant pointed out by direct quotation that the large diameter (above 120 inch diameter) pipe products presented within the reference are made with bolted together plates, *not spirally formed pipe*. The examiner has presented no argument to refute this position. Referring to page 40 of the Handbook the examiner attempts to establish that any corrugation profile and fabrication information presented within the text should be considered as “merely desired corrugation sizes based upon pipe diameter, but should not be limiting to pipes made by the lock seam method with respect to diameter”. The examiner has provided no support for this statement, *it is simply his own opinion*. The examiner asserts that all of the sizes identified by the chart on page 38 apply directly to lock seam pipe, while at the same time he is proclaiming that structural plate pipe cannot be made to all of the sizes identified by the chart. It is disingenuous for the examiner to suggest that a limitation exists for one product, then suggest that no limitation would apply to another product, particularly when the examiner is insisting that the reference anticipates the appellants’ invention. The examiner has not presented an answer that would overcome argument 1. This reference cannot be utilized as an anticipation.

2.) Regarding argument 2, the appellants’ argument was specifically directed to the erroneous language of the rejection. The examiner’s rejection states: “it is noted that conventional pipes of this type are capable of ranging in diameters from 6 inches to 21 feet in diameter”. The appellant asked the following questions: “On what page can the notation be found?, What does the note actually say? and, On what page can one find mention of conventional pipes?”

When the appellant suggested, "if the statement is a paraphrase, or summary, there should be some text within the reference to provide the alleged facts asserted", the thought was that the examiner should be able to provide a direct quote, or some simple explanation, the rejection was after all presented as applying to the appellants' invention under 35 U.S.C. § 102(b).

The contorted reasoning the examiner has provided is completely unacceptable, particularly when you considered wording such as "believed", and terms like "clearly set forth", both of which imply that the information is subjective. The examiner's answer is like rejection A, in that it distorts the teaching of the reference and does not establish by fact, a basis for rejection.

3.) Regarding argument 3, the appellant argued that the examiner's rejection is based upon fabrication. The examiner's answer refers to his earlier statements as somehow providing the needed support for his rejection. The appellants' argument was directed specifically to the contorted teachings of the examiner from the answers of his final office action (please see appeal brief and final action). The examiners answer does not clarify those teachings.

4.) Regarding argument 4, the examiner states, "there is no argument set forth which pertains to inadequacies of the 102(b) rejection, therefore such is not being addressed here".

The appellant has repeatedly set forth arguments that there are no illustrations, photos, text, diagrams, etc. that anticipate the appellants' invention, that there is no basis for a rejection under 102(b). Argument 4 was addressing an earlier answer of the examiner, from the final office action. The current answer does not address the issue (please see appeal brief and final action).

5.) Regarding argument 5, the examiner's answer does not address the appellants' argument. Without providing a fact based showing of where the appellants' claimed invention is found within the Handbook, the examiner asserts that larger sizes of pipe are not structurally different than smaller sizes of pipe, yet basic physics dictate that this cannot be true. There is some discussion of lockseam structure, when such is not the subject of any of the base claims in question. It is implied by the examiner that there is some support for his position found elsewhere in the discussion of rejection under 102(b) but does not explain where, or for that matter what is being discussed. The examiner then admonishes us to accept that any argument as to the relevancy of size is immaterial, but does not provide any basis, or authority for that position. Argument 5 was specifically presented to establish that the size of an article is patentable, particularly when the change in size is the result of invention. The appellant has, at numerous times explained that a large diameter spirally formed pipe as claimed requires special machinery to produce, that it is, in fact, the result of invention. The examiner has not presented an argument to refute this position. The Edison reference is directed specifically to this argument. The examiner uses the phrase; "Edison material has no bearing on the anticipation of the claims by the Handbook", as an authoritative proclamation, but again does not provide any basis, or authority for that position. In as much as the Handbook does not anticipate the appellants' claimed invention, the argument presented provides additional support to illustrate the shortcomings of the examiners position. In other words, the Handbook, does not provide sufficient information to produce the appellants' invention, and absent such information it is inappropriate to assume that the meaning of charts and text can be manipulated in the manner the examiner has suggested.

It should be noted, that the appellant is aware that such manipulation is never allowed when the prior art reference is being utilized as an anticipation under 102(b). There is considerable authority regarding anticipation and inherency, one need only view the many cites provided in the appeal brief pertaining to rejections under 35 U.S.C. § 102 to conclude that there is no conceivable way to manipulate, and draw conclusions as the examiner has done.

6.) Regarding argument 6, the examiner has not provided an answer to the argument. The examiner has implied that no argument has been made to identify the inadequacies of the rejection under 102(b) under the Handbook reference, therefore such is moot, but the examiner is ignoring the actual argument. The argument presented was like argument 5 in that it focused on the fact that it requires invention to produce the large diameter spiral pipe as claimed. The examiner has not refuted this position, and therefore it is believed that the examiner accepts, and agrees that invention is required to produce the claimed invention. It is not possible for the Handbook to anticipate *a spiral pipe* of the size claimed in as much as the equipment required to produce such pipe did not exist, this is particularly true when you consider that the reference does not actually provide any illustrations, photos, text, diagrams, etc. that anticipate the appellants' invention. The examiner has also implied that such an argument would only be valid if such was the subject of a method claim, but does not provide any basis or authority for this position. It is therefore an irrelevant point. The argument presented renders any assertion that the Handbook anticipates the claimed invention invalid. This is, after all, the purpose of the argument.

7.) Regarding argument 7, the examiner has not provided an argument to refute the appellants' position. It is not a moot point as the examiner has suggested, there are many examples found in the reference depicting the field assembly of structural plate pipe, there can be no question that structural plate pipe - a bolted together product, can be made up to 21 feet in diameter. The reference therefore should be expected to provide the same sort of information regarding *spirally formed pipe* that would enable one to produce or ship the product above the 120 inch size. The examiner again discusses the lockseam structure, when such is not the subject of any of the base claims. The appellant has suggested from the response to the second office action, until now, that the handbook reference has been misunderstood by the examiner, it does not provide any illustrations, photos, text, diagrams, etc., that would support a rejection under 35 U.S.C. § 102. Arguments presented that illustrate how the examiner's interpretation of the reference is unacceptable, should have been answered by the examiner. With no answer presented to refute the actual argument, the argument is to be considered valid, the examiner's rejection must be reversed.

8.) Regarding argument 8, the examiner has mistakenly suggested that the appellant has argued that how the pipe was transported to the site was in some way the basis of producing unexpected results. Argument 8 was specifically addressing the various uses for large diameter spiral pipe, such as homes, bridges, grain silos, and so on. The examiner did not address this argument. In as much as the examiner has not addressed this argument, we must conclude that the examiner agrees that the claimed invention produces unexpected results, solves unrecognized problems, and so on, and therefore could not have been anticipated by the Handbook.

9.) Regarding argument 9, the examiner is suggesting in some way that the various embodiments mentioned are referring to the pipe seam, when in fact there are numerous products identified by the Handbook which are complete products, having their own distinct characteristics. When the examiner suggests that the table on page 38 identifies that spiral pipes can be made up to the same diameters as structural plate pipes, the examiner is in fact combining embodiments of one product with embodiments of another product within the same reference, and this is not acceptable when claiming that the reference anticipates the appellants' invention under 35 U.S.C. § 102(b).

10.) Regarding argument 10, the appellant has not presented this information as an argument, but rather as an authority to support several of the earlier arguments. The examiner dismisses the portion pertaining to rejection based on 35 U.S.C. § 103, and then proclaims that "the examiner has stated above that the Handbook reference discloses the appellants claimed lock seam pipe in an anticipatory manner". The examiner did not show how the table on page 38 discloses the appellants' invention. The examiner's only support for this assertion is taken directly from *his own words*. In the examiner's answer to argument 1, the examiner states, "It should be noted by the Board of appeals that the disclosure on page 40 of the Handbook sets forth merely desired corrugation sizes based upon pipe diameter, but should not be limiting to pipes made by the lock seam method with respect to diameter, the recitation on page 40 is merely a recommended corrugation size for a certain diameter of pipe, not a limitation on the diameter the pipe can be made with". The examiner has not provided any evidence or scientific reasoning to support his statement. Though it may be unintended, the examiner is basically asserting that such is obvious.

in which case this rejection would only apply under 35 U.S.C. § 103. This is based directly upon the authority of the MPEP, and not based upon the appellants' opinion. This reference in no way anticipates the appellants' invention. As cited in the appellants' brief the MPEP states, "No question of obviousness is present. In other words, for anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present."

11.) Regarding argument 11, the examiner's answer does not address the actual argument.

Inherency is not being argued at the request of the examiner, it is being argued because the examiner did not show where "the Handbook reference recites all of the claimed structure".

It is apparent from the examiner's statement as quoted above (argument regarding 10), that the examiner is engaging in the practice of proclaiming probabilities or possibilities as the basis for the assertion that the reference of the Handbook anticipates the appellants' invention, and as such argument 11 is provided to present the argument and authority that such is not acceptable.

In that the examiner does not understand the suggestion as to why the Cimiotii Unhairing Co. case is pertinent, it may also be concluded that the Handbook reference is not understood by the examiner as well.

12.) Regarding argument 12, the examiner is basically insisting that any arguments as to how pipes are manufactured or how pipes are shipped are invalid, without such being in the claim language, but does not provide any basis or authority for this position. The claimed invention,

by virtue of its size, has inherent limitations, and as such these limitations are properties of the claimed invention, and as properties of the claimed invention they are in fact functional limitations which are included by the claims. In other words, the pipe as claimed is a finished product, it does not lend itself to field assembly as does structural plate, it must somehow be manufactured at, or shipped to the job site, this is in fact an inherent characteristic of the large diameter spiral pipe as claimed. It should be noted that the appellants' application and brief disclose the existence of new machinery capable of producing and arching spiral pipes at the job site, providing background to establish that the large diameter spiral pipe as claimed is now possible. The examiner has not demonstrated how the reference of the Handbook makes the production of large diameter spirally formed pipe possible or, how it might be shipped, etc.

Again, Inherency is not being argued at the request of the examiner, it is being argued because the examiner did not show where "the Handbook reference recites all of the claimed structure". Please refer to section 10 and 11 above for the appellants' position regarding this issue.

The examiner has taken the extraordinary step of denying the relevancy of all the argument and authority presented simply because he did not authorize an argument based on inherency. While the cites and authorities provided are in some ways self explanatory, I will briefly explain each.

In light of the argument pertaining to manufacture, shipping, and machine modifications required, the examiner has not explained how the handbook reference discloses the complete and operative invention in such full, clear, and exact terms as to enable any person skilled in the art to which it pertains to practice the invention. § 119. Sufficiency of description (60 Am Jur 2d.) Along the

same line of reasoning, the examiner has not shown how the Handbook reference is so particular and definite that one versed in the art could gain possession of the claimed subject matter without undue experimentation. In re Sheppard, 52 CCPA 859, 339 F2d 238, 144 USPQ 42.

The examiner does not believe he is required to address arguments pertaining to inherency, but the D.Del. 1990 decision would apply even if the examiner had demonstrated that the appellants' claimed invention can be found within the Handbook reference. The argument of course is pertaining to manufacture, shipping, and machine modifications required for one to practice the appellants' invention. "Even if a prior printed publication discloses the claimed invention, it will not suffice as prior art if it was not enabling; therefore, defendant must show that each element of claim in issue is found in the prior patent or publication, either expressly or under the principles of inherency and that one of ordinary skill in the art could have combined the publication's description of invention with his own knowledge to make the claimed invention."

35 U.S.C. § 102(b). General Elec. Co. v. Hoechst Celanese Corp., 740 F.Supp. 305.

The examiner has consistently refused to answer this question. How do we actually produce a spirally formed pipe of the size claimed, based upon the reference cited? Absent a clear argument from the examiner regarding this issue we must conclude that the reference does not anticipate the appellants' invention, therefore the examiner's decision must be reversed.

The Handbook reference specifically refers to structural plate when presenting pipes of a size that would meet the appellants' claims. The physical difference between these two products are

unmistakable. The structural plate pipe - a bolted together product, is easily field assembled, where *spirally formed lock seam pipe* cannot be field assembled. The D.Del. 1989, decision states, "Any degree of physical difference between inventions, however slight, invalidates claims of anticipation in a patent infringement action". E.I. du Pont de Nemours & Co. v. Polaroid Graphics Imaging, Inc., 706 F.Supp. 1135, affirmed 887 F.2d 1095, rehearing denied.

13.) Regarding argument 13, the examiner has, either not actually read the argument or is ignoring the basis of the argument. In either case the examiner has chosen not to address this argument. Within the argument, the appellant has provided an example of how the claimed invention can function, and some of the advantages to be gained by utilizing the invention. Contained within the argument is the statement, "The bolted together pipe products shown in The Handbook of Steel Drainage, do not function the same way as the appellants' invention , they do not produce the same results." This statement has not been challenged by the examiner. The two cites relied upon by the appellant speak directly to the functionality and results. The Handbook reference does not anticipate the appellants' invention, the examiner's decision must be reversed, which action the appellant now respectfully requests.

14.) Regarding argument 14, the examiner provides several sentences containing quoted material from the Holcomb reference along with examiner comments. The examiner does not provide a quotation from the reference that can be viewed as anticipating the appellants' invention, but does

lead us right to a point where spiral pipe is being discussed then stops at column 2, line 4. It is disingenuous for the examiner to quote from the reference to line 4, and leave out the next two lines which include the statement "with diameters up to twelve feet". Instead the examiner states, in his own words, "the reference to Holcomb sets forth that lock seam pipes are known in the art as set forth by the Handbook reference, and that such pipes can have a diameter up to 21 feet." This statement is unsupported by the Holcomb reference. The examiner presents no theory for obviousness, but rather directs us to accept that he has somehow established anticipation by stating "it is held by the examiner that if one takes the teaching as a whole of the reference to Holcomb, including what is old and known in the art as set forth in the background of invention in Holcomb, and further describes the teachings of the Handbook reference, then the language of claims 1-4 is anticipated by the disclosure of the Holcomb patent." The appellant is aware that anticipation can not be established by probabilities or possibilities, the examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). The examiner has provided no such evidence or reasoning with regard to this reference. It can also be presented just as in an earlier argument, that in as much as the examiner is insistent that this reference somehow anticipates the appellants' invention, the reference must be confusing to the examiner and as such, a reference so obscure in its terminology that two conflicting theories as to its meaning may be deduced therefrom and supported by equally plausible arguments is too indefinite to be utilized as an anticipation. (see Cimiotti Unhairing Co.

et. al v. Comstock Unhairing Co. et. al., 115 Fed. Rep. 524.) The Holcomb reference can not be utilized to support a rejection under 35 U.S.C. § 102(b).

The remainder of the examiner's answer to 14, is directed to defending his statement regarding the alleged testing of pipes. The examiner's basic contention appears to be that Holcomb would only provide tables with "random numbers" to suggest some sort of testing, and that even if the examiner was incorrect, the use of the term "tested" was "a mere attempt to simplify the terminology and not further confuse the argument at hand." The appellant suggests that such reasoning is bizarre. There is no clarity brought to an argument when material is misrepresented. The examiner's contention that the tables present "random numbers" is also inaccurate. Table A provides a logical progression of sizes from 12 inches to 60 inches, and table B provides a logical progression of sizes from 48 inches to 108 inches. When you consider these sizes in context with what the reference teaches in column 2, lines 4-10, and also review the dimensioning applied in FIG. 2A and 3, you will find a product with a ½ inch and 1 inch corrugation depth respectively. According to the Holcomb reference, and the Handbook reference page 40, these corrugation depths apply to spirally formed pipes up to twelve feet. The tables accurately depict that the Holcomb invention provides for pipes that are logically smaller than twelve feet, a range that makes logical sense when you consider it is the intention of Holcomb to provide a product that will be less expensive than the competitive products. The Holcomb reference does not anticipate or in any way render obvious a pipe product that would meet the appellants' claimed invention. The examiner did not actually answer the appellants' questions. In his rejection the examiner stated "it is implied that the pipe in Holcomb can be made up to those dimensions if such were

needed". Where is it "implied"? Also can the examiner hold the position "if such were needed" and still prove the motivation required to support a case for obviousness? The examiner did not answer these questions because there is no logical basis for his rejection. The examiner's rejection must be reversed, which action the appellant now respectfully requests.

15.) Regarding argument 15, the examiner's answer is directed to his misstatements regarding the alleged testing of pipes, and how that may somehow be interpreted as the basis for the appellants' arguments regarding hindsight reasoning. This of course is not a basis of hindsight reasoning. *It is simply a fabrication.* The actual argument was directed to the inadequacies of the examiners final office action. There are several arguments presented in the appellants' Amendment B (December 26, 2000), which remain unanswered. There are arguments which fully develop the teachings of the references, providing technical detail, clearly defeating the examiners position. The examiner's response seldom identifies the arguments he is addressing. For one argument he simply states it is "not considered persuasive". It must be restated, the examiner's answers are replete with distortions and unfounded statements. There is no basis for the examiner's grounds of rejection B.

16.) Regarding argument 16, the appellant presented a very clear and concise argument, a simple review of the material supports the argument. The appellants' reference to the content of the Handbook on page 40 cannot be misunderstood. The examiner is attempting to present that the appellants' arguments are like his own, somehow containing distortions and misrepresentations.

The appellant did not refer to page 38 or 39 of the Handbook reference, but let's look at what the examiner is attempting to suggest. The examiner claims that the appellant is discounting the information on page 39 which indicates that pipes can be made which exceed 96 inches. Of course 96 inches is not twelve feet, and as far as the appellant is aware *shop-fabricated* pipes were made with rivets prior to 1931, and the fact is, page 38 does not contain a recitation regarding pipe sizes, in as much as the phrase implies that something has been recited. These types of distortions appear quite often within the examiner's answer. The Holcomb reference definitively teaches away from the suggested combination, and of course any argument of anticipation is irrelevant. The examiner's answer does not overcome the argument, therefore the examiner's rejection must be reversed.

17.) Regarding argument 17, the examiner simply reasserts his position that Holcomb anticipates the appellants' invention, providing the basis for this position, with his own words, no evidence or scientific reasoning has been presented. Once again we are presented with distorted teachings, such as; "There is nothing conflicting in the Holcomb reference, when such clearly sets forth what is old and known in the art, specifically pipes up to 21 feet in diameter being made with lock seams". This statement has been presented as though it were fact. The examiner does not qualify the statement with an opening comment, "When, in my opinion" or anything of that sort, he is simply engaging in outright fabrication. The rest of his comments focus on the alleged testing of pipes issue, which is confusing in that, if the earlier fabricated statement were actually true, and if such testing were actually implied, there would be no need for such a discussion.

The examiner has not actually addressed argument 17 (please see argument 17). The examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). The examiner has provided no such evidence or reasoning with regard to this reference. The examiner's rejection must be reversed.

18.) Regarding argument 18, the examiner is avoiding the actual argument with an unsupported, attempt at authoritative sounding dialogue. The examiner states, "such an argument is more detailed than the language of the claim and therefore a moot point when such cannot be argued against the reference when such is not a limitation that the Holcomb reference is required to meet". Logically this cannot be true, there can be no limitation to the amount of detail an argument is allowed to contain, and the Holcomb reference is required to provide proof that it could be utilized to enable one skilled in the art to produce a pipe that would anticipate or render obvious the appellants' invention. Next the examiner refutes the § 119 authority as not being applicable to Holcomb in as much as Holcomb is not a "prior art printed publication". It is the contention of the appellant that since the Holcomb reference relies exclusively upon teachings from the Handbook, and that the authority identifies some requirements of anticipation under 35 U.S.C. § 102, that there is no basis to ignore it's relevancy. The remainder of the examiner's answer follows the same pattern, dismissing relevancy, then not providing an answer. The basic argument "there is nothing in the reference that would enable one skilled in the art to produce a

spirally formed pipe of any size”, has not been addressed by the examiner. The importance of this argument cannot be overstated. The Handbook was published in 1971, and the Holcomb patent was filed in 1987, the existence of machinery capable of producing the products identified by the references was very well known by these dates, there would be no requirement for the references to disclose how such pipe could be made. However, when the examiner suggests that the references teach something beyond what is actually taught, it is, the examiner’s responsibility to provide proof to support his position. The fact is, Holcomb does disclose information regarding *length limitations*, how handling, transportation and manufacturing are affected. Starting on the last line of column 3 and proceeding to column 4, line 5 the reference states “The length of pipe 10 which is produced is limited only by the length of the original steel strip stock material, the handling facilities of the production plant, and transportation equipment. In practice, a saw is provided to saw the completed pipe into suitable lengths for handling and transportation.” It is completely illogical to think that Holcomb would be concerned about length limitations and totally ignore any problem a large diameter pipe might present. The very fact that Holcomb presented information regarding the existence of limitations that are created by handling and transportation needs, demand that the examiner somehow demonstrate how such problems can be overcome with regard to larger diameter pipes, also the examiners answer has not provided any evidence to “explain the necessary modifications required for the factory machinery to produce larger sizes of pipe, i.e., tooling, pipe support modifications, etc.” The, General Elec. Co. v. Hoechst Celanese Corp., 740 F.Supp. 305, cite speaks directly to this argument. The examiner has not presented an answer to this argument, the examiner’s rejection B, must be reversed.

Argument 18, did not actually present any assertions regarding the various uses for *large diameter spiral pipe*, but in as much as the examiner brought up the issue, it is important to note that arguments have been presented to illustrate that the claimed invention provides for unexpected results, unappreciated advantages, and solves unrecognized problems, not found within these references, and these arguments have not been appropriately addressed by the examiner. (see amendment B)

19.) Regarding argument 19, the examiner has dismissed the first three paragraphs as not setting forth any argument, but it is apparent from the examiner's answer that the simplicity of the invention is a major stumbling block for the examiner. The examiner states, "one skilled in the art would not find any part of acquiring a spirally formed lock seam pipe that had a diameter larger than 15 feet to be anything other than a predictable outcome", and *then jumps right into his own distorted teachings* (earlier argument has been presented to illustrate the examiners propensity to engage in fabrication, example, see 17 above, it should not be necessary for the appellant to support this position each time the examiner presents this type of statement). There is no support for the assertion regarding "predictable outcome", it is simply an opinion of the examiner. The examiner, in a way, is suggesting that applicability of this reference under 35 U.S.C. § 103 is just a back up position, to be used only if the rejection under 35 U.S.C. § 102 does not stick. The fact of the matter is the examiner has never presented an argument to illustrate how the appellants' invention is obvious in Holcomb, he has simply implied that such is the case. The relevancy of hindsight is brought up since the only mention of a *spiral pipe* above 15 feet in diameter is found in the appellants' disclosure, not in the prior art. The SAF-GARD Products cite is applicable.

Next, the examiner proclaims "the question of desirability is not being addressed in that such is merely *assumptions made by the applicant*". This would suggest that the examiner did not read the argument, which states:

It is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F. 2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.) cert. denied, 488 U.S. 825 (1988).

According to the Manual of Patent Examiners Procedures, "*The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.*"

The examiner has stated "Holcomb can also be made up to those dimensions if such were needed" (page 3 of the final office action). This would imply that the examiner does not see any desirability in doing what the inventor has done. There is no teaching, suggestion or inference in the prior art to support a rejection under 35 U.S.C. § 103.

These are not *assumptions made by the applicant*, the examiner has not presented an answer to address desirability. The examiner's grounds of rejection B, must be reversed.

20.) Regarding argument 20, the examiner states “pipes can be formed with lock seams and formed with diameters up to 21 feet”, but does not provide any support for the statement.

The examiner then states, “The desirability of doing so would be that one skilled in the art would find it obvious to vary the diameter of the pipe to meet his needs and that such does not require more than routine skill in the art to form a pipe of larger diameter, especially when the patent to Holcomb teaches that such is old and known in the art to do”, the examiner has not provided any support for his statement, there is no mention of *spirally formed pipe* within this statement, structural plate pipe, of course is the only pipe mentioned within the references that are produced above twelve feet in diameter. The examiner presents an additional statement regarding motivation as follows: “The motivation to modify the Holcomb reference is clear, if one needs a pipe of a larger diameter for use in large spillways, or other applications utilizing large pipe diameters, one would be able to utilize the teachings of Holcomb to know that such is possible in the art”. The examiner has not mentioned spiral pipe in this statement, there is no suggestion of what is being modified, therefore there is no basis to connect the phrase, “to know that such is possible in the art”, to *spirally formed pipe*. It should also be noted that even if these answers supported desirability, they do not fully address argument 20, which requires, the examiner must *also present* that there would be *a reasonable expectation of success*, this requirement has not been met.

The examiner has again asserted that how pipes are manufactured or how pipes are shipped is invalid, without such being in the claim language, but does not provide any basis or authority for

this position. The claimed invention, by virtue of it's size, has inherent limitations, and as such, these limitations are properties of the claimed invention, and as properties of the claimed invention they are in fact functional limitations which are included by the claims. In other words, the pipe as claimed is a finished product, it does not lend itself to field assembly as does structural plate, it must somehow be manufactured at, or shipped to the job site, this is, in fact an inherent characteristic of the large diameter spiral pipe as claimed. The appellant was suggesting that this presents a significant problem to any answer the examiner might present regarding *the reasonable expectation of success requirement*. The fact is, the examiner has presented no answer to address this requirement. The In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) cite is valid, the examiner's rejection must be reversed.

The examiner concludes his answer with the suggestion that appellant has set forth several cases but has provided no argument to support those cases, so therefore these cases have no weight. It is the appellant's position that these cites are self explanatory as to their pertinence, but in as much as the examiner has not recognized the need for such cites, the appellant will explain.

The examiner is required to provide *evidence* of a suggestion, teaching, or motivation to modify the reference, the showing must be clear and particular. See e.g., C. R. Bard, Inc. v. M3 Sys., Inc., 157 f.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) The examiner has not provided any *evidence* of a suggestion, teaching, or motivation, to modify the reference.

The appellant, described above that the examiner did not support his statement.

When the examiner makes such a statement it is "a broad conclusory statement" regarding the obviousness of modifying a reference and, standing alone it is not "evidence". E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

When the examiner provides a statement to establish his belief that the appellants' invention is somehow obvious, and does not include support for such a statement, it is simply a conclusory statement. In other words, it is a statement provided to draw a conclusion. "Mere denials and conclusory statements, however are not sufficient to establish a genuine issue of material fact."; In re Sichert 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). Broad conclusory statements are all the examiner has provided, and within these statements there are obvious mistakes of a factual nature. The examiner's grounds of rejection B, must be reversed, which action the appellant now respectfully requests.

21.) Regarding argument 21, the first half of the examiner's answer is directed to grounds of rejection C, and his statement regarding the suggestion that arched pipe is somehow stronger than round pipe. The examiner expends considerable effort to establish that he was somehow implying that his statement was merely addressing an issue of strength and economy, but then turns around and proclaims that it is actually "*a direct quote from the reference itself*". The examiner then presents that "the section *quoted* above from page 39 of the Handbook provides the necessary motivation to make a pipe into an arched shape", based on the examiner's statement about "*a direct quote*", as mentioned above we really have no idea what he means. Next the examiner states that Holcomb *directly quotes* the teachings of the Handbook, and implies that there is some

discussion of “*making pipes into arc shapes*”, there of course is no mention of “*making pipes into arc shapes*”, the examiner provided this information in an attempt to establish the motivation to combine the teachings of the references. The Federal Circuit states that “(the) mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification”. In re Fitch, 972 F.2d 1260, 1266 n.4, 23 USPQ2d 1780, 1783-84 n.4 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner’s answer is simply a fabrication, there is nothing in the answer that would overcome argument 21. The examiner’s grounds of rejection C, must be reversed, which action the appellant now respectfully requests.

The examiner’s grounds of rejection C, states, that “Holcomb discloses all of the recited structure with the exception of reshaping the tube as an arch”. *This has not been established, Holcomb does not disclose a spirally formed pipe above twelve feet. With this in mind, grounds of rejection C is completely irrelevant, and must be reversed.*

22.) Regarding argument 22, in as much as the examiner has stated that the motivation to combine the references was set fourth above, the examiner’s answer is now irrelevant. Absent a valid suggestion of the desirability of doing what the inventor has done, a presentation regarding the reasonable expectation of success cannot meet the examiner’s requirements of providing for both, the suggestion of the desirability, and the reasonable expectation of success. The examiner’s grounds of rejection C, must be reversed, which action the appellant now respectfully requests.

The appellant will, however, address the examiner's answer, to show how the examiner's reasoning regarding the expectation of success, and the various cites presented is flawed. The first portion of the examiner's answer, again does not mention *spirally formed* pipe at all, and there is a complete absence of any supporting content mentioned, the same is true when the examiner is presenting his comments regarding the reasonable expectation of success. All of these statements are therefore simply broad conclusory statements, as was defined by the appellant earlier.

The examiner suggests that the appellant has somehow implied that to produce a spiral pipe from a factory machine up to forty feet in diameter could be possible for one skilled in the art, but this is of course another distortion. The examiner is aware that the argument also includes the following statement: "Additionally, the appellant notes that the factory machinery would require modifications not taught in the prior art to produce pipes as claimed, and the Arching Equipment to arch pipes as claimed did not exist".

The examiner again, dismisses the cites at the conclusion of argument 22 as not pertinent.

Obviously the In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) cite is valid.

The examiner did not provide any suggestion of the desirability of doing what the inventor has done, along with a suggestion that there would be a reasonable expectation of success.

The examiner has not provided any evidence of a suggestion, teaching, or motivation to modify any of the references or combination of references. The showing must be clear and particular.

See e.g., C. R. Bard, Inc. v. M3 Sys., Inc., 157 f.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) The examiner's answer in support of obviousness is simply a broad conclusory statement regarding the obviousness of modifying a reference, standing alone it is not "evidence". E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

"Mere denials and conclusory statements, are not sufficient to establish a genuine issue of material fact."; In re Sichert 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

Broad conclusory statements are all the examiner has provided, and within these statements there are obvious mistakes of a factual nature. The examiner's grounds of rejection C, must be reversed; which action the appellant now respectfully requests.

CONCLUSION

The appellant has repeatedly demonstrated that the examiner has a propensity to engage in fabrication. It can also be stated that the examiner has *taken* from me. Both in terms of time and money, but even more important, he has attempted to take my constitutional right to this patent. The appellant is aware that in civil proceedings there is a doctrine of "Unclean Hands" that applies when either side of a court case, knowingly, engages in fabrication. This doctrine, as I understand it would not allow the offending party to obtain relief from the court in such an action. It seems extremely unfair that I have had to work through this entire process with this same examiner. I cannot begin to understand why this examiner decided to take such an obstinate position.

From our earliest communication to the present, there has never been any give and take, this is the reason the appellant found it necessary to include the request regarding the earlier amendment pertaining to the rejection under 112. It is still the appellants' position that the claims should be restored to there "*pre-amendment A condition*". There was no other change resulting from amendment A, and if it is somehow within the purview of the Board to direct this to happen, it would be greatly appreciated.

The appellant spent, what seemed like countless hours gathering information, seeking out appropriate cites and authority, and in general trying to determine how an appeal should be presented, please accept my apology if it is lacking in any way. By contrast it does not escape my notice that the examiner has not provided any authority or cites to support his position. The short comings of the examiner are however, unimportant. The fact is, I deserve this patent. Please accept this appeal, and Reverse the Examiner.

Very Respectfully,

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Certificate of Mailing: I certify that on the date below this document and referenced attachments, if any, will be deposited with the U.S. Postal Service as first class mail in an envelope addressed to: "ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, DC 20231."

January 3, 2002

Scott E. Johnston, Applicant/Appellant